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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,070	05/03/2001	Kenny K. Fok	M-11531 US	7836

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KYOCERA WIRELESS, CORP.
P.O. BOX 928289
SAN DIEGO, CA 92192-8289

EXAMINER

DANIEL JR, WILLIE J

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,070

Applicant(s)

FOK, KENNY K.

Examiner

Willie J. Daniel, Jr.

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05/03/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) /
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to because of **Form PTO-948** section 5 and 10. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: Ref. "**200**" refers to wireless communications network on page 7, line 12 and a block on page 10, line 17.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

A person shall be entitled to a patent unless –

Claims 1 - 15 are rejected under 35 U.S.C. 102(e) as being anticipated by **Gudjonsson et al.** (US 6,564,261).

Regarding **Claim 1**, Gudjonsson et al. disclose a method for allowing a user of a wireless communications device (11, 14) to participate in an instant messaging service, wherein the wireless communications device (11, 14) is connectable to a wireless communication network adapted to handle messages in short message service format, and wherein the wireless communication network includes a proxy server (21, 23) (see col. 3, lines 46-63; col. 7, lines 53 - col. 8, line 3; col. 9, lines 41-54; col. 11, lines 21-27; Figs. 1, 4, 13), the method comprising:

receiving an indication that the wireless communications device (11, 14) is placed in an active state (see col. 3, line 1-9; col. 7, line 53 - col. 8, lines 30; col. 8, lines 53-65; col. 11, lines 33-57; Fig. 8, 19, 22, 23), where the status of users is updated whenever there is a change;

establishing a data connection between the wireless communications device (11, 14) and the wireless communications network (see col. 3, lines 14-17; col. 7, line 53 - col. 8, line 30; Figs. 1-7, 19, 21);

transmitting from the proxy server (21, 23) to the instant messaging service presence information indicating that the user is online (see col. 11, 21-27; col. 17, lines 5-43; Fig. 8); terminating said data connection (see col. 11, line 45-57; Fig. 8, 20, 21), where the proxy server (21, 23) provides the status of connection while the mobile device is on or active but idle; and maintaining said presence information for the user while the wireless communications device (11, 14) remains in said active state (see col. 3, line 1-9; col. 7, line 53 - col. 8, lines 30; col. 8, lines 53-65; Fig. 8).

Regarding **Claim 2**, Gudjonsson et al. disclose a method further comprising receiving at the proxy server (21, 23) an instant message from a sender, said instant message addressed to the user (see col. 10, lines 8-21; col. 11, lines 21-27; Figs. 4, 6, 13), where the instant message goes through a proxy server (21, 23) to a cellular communications network; and intercepting said instant message (see col. 10, lines 8-21; col. 11, lines 21-27; Figs. 4, 6, 13), where the instant message is transmitted through the proxy server.

Regarding **Claim 3**, Gudjonsson et al. disclose of method notifying the user that said short text messages which hereinafter reads on the claimed "instant message" has been received (see col. 24, lines 16-25; col. 33, lines 38-44; col. 36, lines 56-60), where the user is notified of messages received in the inbox.

Regarding **Claim 4**, Gudjonsson et al. disclose a method wherein said notifying comprises converting at least a portion of said short text message which reads on the claimed "instant message" to short message service format (see col. 10, lines 8-21; col. 36, lines 12-25, 56-62; Figs. 1, 2, 3, 4, 5, 6, 13), where the instant message is converted at the proxy; and

sending said converted message to the user (7) (see col. 3, lines 46-63; see col. 10, lines 8-21; col. 36, lines 12-25, 56-62; Figs. 1, 2, 3, 4, 5, 6), where the message is converted, truncated, and transmitted to the user's device.

Regarding **Claim 5**, Gudjonsson et al. disclose a method wherein said converted message includes no more than 205 characters (see col. 36, 22-24), where converting the message truncates the message to the maximum size allowed by the supporting network (e.g., SMS format supports less than 205 characters).

Regarding **Claim 6**, Gudjonsson et al. disclose a method further comprising converting an identifier (UID) of the sender of said instant message to short message service format and sending said identifier (UID) to the user in conjunction with said converted message (see col. 1, 56-62; col. 8, lines 47-51; col. 16, lines 7-19; Figs. 8, 12a, 12b, 16, 18b), where the sender/user has an identifier (UID) that is associated with different servers/clusters during the sending of message(s).

Regarding **Claim 7**, Gudjonsson et al. disclose a method wherein said notifying comprises transmitting a message to the user in short message service format that an instant message has been received (see col. 24, lines 16-25; col. 33, lines 38-44; col. 36, lines 12-25, 56-60; Figs. 14, 15).

Regarding **Claim 8**, Gudjonsson et al. discloses a method wherein said message transmitted to the user includes an identifier associated with the sender of the instant message (see col. 1, 56-62; col. 8, lines 47-51; col. 16, lines 7-19; Figs. 8, 12a, 12b, 16, 18b), where the sender/user has an identifier (UID) that is associated with different servers/clusters during the sending of message(s).

Regarding **Claim 9**, Gudjonsson et al. disclose a further comprising:

- storing said instant message (see col. 17, lines 38-44);
- establishing a data connection between the wireless communications device (11, 14) and the wireless communications network (see col. 3, lines 14-17; col. 7, line 53 - col. 8, line 30; Figs. 1-6); and
- transmitting said stored instant message to the wireless communications device (11, 14) over said data connection (see col. 9, lines 41-54; col. 10, lines 8-21; col. 36, lines 22-32, 56-62; Fig. 1-6), where messages are transferred between devices.

Regarding **Claim 10**, Gudjonsson et al. disclose a method further comprising receiving at the proxy server (21, 23) a response to said instant message (see col. 37, lines 23-33).

Regarding **Claim 11**, Gudjonsson et al. disclose a method wherein said receiving comprises:

- establishing a data connection between the wireless communications device (11, 14) and the wireless communications network (see col. 3, lines 14-17; col. 7, line 53 - col. 8, line 30; Figs. 1-6, 19, 21);
- receiving at the proxy server (21, 23) a message transmitted in instant message format via said data connection (see col. 10, lines 8-21; col. 11, lines 21-27; Figs. 4, 6, 13); and
- transmitting the message in instant message format (see col. 9, lines 41-54; col. 10, lines 8-21; col. 36, lines 22-32, 56-62; Fig. 1-6).

Regarding **Claim 12**, Gudjonsson et al. disclose a method wherein said receiving comprises:

receiving at the proxy server (21, 23) a message transmitted in short message service format (see col. 3, lines 46-63; col. 10, lines 8-21; col. 36, lines 12-25, 56-62; col. 37, lines 23-33; Figs. 1, 2, 3, 4, 5, 6, 13), where the user responds or sends a message to a another user through the proxy which converts the message to instant message or short text message format;

converting the message to instant message format (see col. 3, lines 46-63; col. 10, lines 8-21; col. 36, lines 12-25, 56-62; Figs. 1, 2, 3, 4, 5, 6, 13), where the user responds or sends a message to a another user through the proxy which converts the message to instant message or short text message format; and

transmitting the message in instant message format (see col. 9, lines 41-54; col. 10, lines 8-21; col. 36, lines 22-32, 56-62; Fig. 1-6).

Regarding **Claim 13**, Gudjonsson et al. disclose a method further comprising:

receiving an indication that the wireless communications device (11, 14) is no longer in an active state (see col. 3, line 1-9; col. 7, line 53 - col. 8, lines 30; col. 8, lines 53-65; Fig. 8, 20, 21, 22), where user has a change of status; and

transmitting from the proxy server (21, 23) to the instant messaging service presence information indicating that the user is offline (see col. 3, line 1-9; col. 7, line 53 - col. 8, lines 30; col. 8, lines 53-65; col. 11, lines 33-57; Fig. 8, 19, 22, 23), where the status of users are updated whenever there is a change.

Regarding **Claim 14**, Gudjonsson et al. disclose a method wherein said receiving an indication that the wireless communications device (11, 14) is no longer in an active state (see col. 3, line 1-9; col. 7, line 53 - col. 8, lines 30; col. 8, lines 53-65; col. 11, lines 33-57;

Fig. 8, 19, 22, 23), where the status of users are updated whenever there is a change comprises:

transmitting at least one message in short message service format to the wireless communications device (11, 14) (see col. 3, lines 46-63; see col. 10, lines 8-21; col. 36, lines 12-25, 56-62; Figs. 1, 2, 3, 4, 5, 6); and

determining that at least one said message in short message service format is undeliverable (see col. 17, lines 1-43), where a network problem can have messages undeliverable which causes a notification message sent and messages will be stored.

Regarding **Claim 15**, Gudjonsson et al. disclose a method for allowing a user of a wireless communications device (11, 14) to participate in an instant messaging service, wherein the wireless communications device (11, 14) is connectable to a wireless communication network adapted to handle messages in short message service format, and wherein the wireless communication network includes a proxy server (21, 23) (see col. 3, lines 46-63; col. 7, lines 53 - col. 8, line 3; col. 9, lines 41-54; col. 11, lines 21-27; Figs. 1, 4, 13), the method comprising:

receiving an indication that the wireless communications device (11, 14) is placed in an active state (see col. 3, line 1-9; col. 7, line 53 - col. 8, lines 30; col. 8, lines 53-65; col. 11, lines 33-57; Fig. 8, 19, 22, 23), where the status of users is updated whenever there is a change;

establishing a data connection between the wireless communications device (11, 14) and the wireless communications network (see col. 3, lines 14-17; col. 7, line 53 - col. 8, line 30; Figs. 1-6, 19, 21);

transmitting from the proxy server (21, 23) to the instant messaging service presence information indicating that the user is online (see col. 11, 21-27; col. 17, lines 5-43; Fig. 8, 19, 20);

terminating said data connection (see col. 11, line 45-57; Fig. 8, 20, 21), where the proxy server (21, 23) provides the status of connection while the mobile device is on or active but idle;

maintaining said presence information for the user while the wireless communications device (11, 14) remains in said active state (see col. 2, line 16-23; col. 3, lines 14-17; col. 7, line 53 - col. 8, line 30; Figs. 1-6, 8, 19, 21, 22), where presence information is maintained;

receiving at the proxy server (21, 23) an instant message from a sender, said instant message addressed to the user (see col. 10, lines 8-21; col. 11, lines 21-27; Figs. 4, 6, 13), where the instant message goes through a proxy server (21, 23) to a cellular communications network;

intercepting said instant message (see col. 10, lines 8-21; col. 11, lines 21-27; Figs. 4, 6, 13), where the instant message is transmitted through the proxy server;

notifying the user that said instant message has been received (see col. 24, lines 16-25; col. 33, lines 38-44; col. 36, lines 56-60), where the user is notified of messages received in the inbox;

receiving an indication that the wireless communications device (11, 14) is no longer in an active state (see col. 3, line 1-9; col. 7, line 53 - col. 8, lines 30; col. 8, lines 53-65; Fig. 8, 20, 21, 22), where user has a change of status; and

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transmitting from the proxy server (21, 23) to the instant messaging service presence information indicating that the user is offline (see col. 17, lines 1-43), where a network problem can have messages undeliverable which causes a notification message sent and messages will be stored.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. **Mukherjee et al. (US 6,289,223)** discloses *System and Method for Selective Multipoint Transmission of Short Message Service Messages*.
- b. **Singh (US 6,405,035)** discloses *System and Method for Forwarding Messages to a Subscriber Device*.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Willie J. Daniel, Jr. whose telephone number is (703) 305-8636. The examiner can normally be reached on 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-3180.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-5424.

WJD,JR/wjd,jr
18 December 2003

Marsha D Banks-Harold
MARSHA D. BANKS-HAROLD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600